

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

ILLUMINA, INC.,  
Plaintiff,

v.

NATERA, INC.,  
Defendant.

Case No. [18-cv-01662-SI](#)

**ORDER RE JOINT DISCOVERY  
DISPUTE LETTER NO. 1**

Re: Dkt. No. 128

On June 24, 2019, the parties submitted a joint discovery dispute letter regarding Illumina's alleged refusal to comply with Natera's Request for Production of Documents No. 10. Dkt. No. 128. The document request seeks "all documents pertaining to ... any litigation in which Illumina was involved relating to non-invasive prenatal testing..." Dkt. No. 128-1 at 10. Illumina explains this request implicates at least 12 separate litigations in the United States alone and is overbroad and unduly burdensome.

Natera cites various cases in support of the proposition that courts have compelled production of prior litigation documents similar to Natera's request. Dkt. No. 128 at 2-3. However, those cases are distinguishable. For example, in *Johnson & Johnston v. R.E. Serv. Co.*, No. C 03-2549, LEXIS 26973, (N.D. Cal. November 2, 2004), the court ordered production of prior litigation documents because the exact same parties were involved in the prior litigation and one party had retained new counsel who did not have all the documents from the prior litigation.

In *Wyeth v. Impax Labs, Inc.*, 248 F.R.D. 169, 170, 2006 U.S. Dist. LEXIS 79761, a party made a request similar to Natera's here – seeking all documents from a prior litigation. There the court found that producing documents in connection with claim construction, validity, and enforcement of the patent sufficiently responded to the request. This Court agrees that this strikes

1 a reasonable balance.

2 Therefore, Illumina is ordered to produce the following documents from prior cases related  
3 to non-invasive prenatal testing: (1) all claim construction, validity, and enforcement documents  
4 regarding the '430 patent; (2) documents regarding damages pertaining to the Patent Pool, and (3)  
5 deposition transcripts/exhibits for Illumina witnesses that will be deposed in this case.

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7 **IT IS SO ORDERED.**

8 Dated: July 2, 2019

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SUSAN ILLSTON  
United States District Judge